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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,900	01/14/2004	Martin Vorbach	2885/76	4767

7590 02/01/2007

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EXAMINER	
BRITT, CYNTHIA H	
ART UNIT	PAPER NUMBER
2138	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/757,900	VORBACH ET AL.	
	Examiner	Art Unit	
	Cynthia Britt	2138	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-24 and 26-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-24 and 26-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 January 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/598,926.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *IDS Not considered*.

DETAILED ACTION

Claims 1—24 and 26-46 are presented for examination.

Information Disclosure Statement

M.P.E.P section 2004 (Aids to Compliance With Duty of Disclosure) recites the following:

> 13. It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff 'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974). But cf. Molins PLC v. Textron Inc., 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

It is noted that the IDS of 5/24/04 is 10 pages long, and the IDS of 11/9/06 is 3 pages long citing an additional 87 documents and the combination of these two represents multiple *thousands* of pages of highly technical disclosure, which meets the test of a "long list". Moreover, a number of the references do not appear to be material to the patentability of the claimed invention, for example, consider the Cooper patent in the IDS of 5/24/04. The disclosure in Cooper appears non-analogues to the claimed invention, drawn to rotary driven gears. Also, the Gubbins patent pertains to an electric motor. Therefore, the determination of whether or not references are material to the patentability appears to be an issue. The references cited in the IDS of 5/24/04 will not be considered until an *underlining* of the most relevant documents is provided, per

M.P.E.P. 2004. Please do not delineate the references using a highlighter since the documents will be scanned and the highlighted sections will not be visible.

Applicant's forthcoming assistance is gratefully anticipated. The following is also required:

A. Stipulate whether each and every individually cited reference listed on the IDS(s) submitted May 24th 2004 and November 9, 2006is material to the patentability of the instant application; the applicant may either *agree* or *disagree* for each cited reference.

1. Identify, for each and every citation listed on the IDS(s) submitted May 24th 2004 and November 9, 2006, for which applicant *agrees* is material to the patentability:

a. The differences between the claimed invention and those references cited therein,

b. How each reference is material to the patentability, based upon the technical and legal knowledge of the Applicant, of the claimed invention,

c. Provide how the instant claimed invention is an improvement over each and every reference that is listed in the IDS submission(s) dated May 24th 2004 and November 9, 2006.

B. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) *used in drafting the instant application, whether cited or not* in the IDS submission(s) dated May 24th 2004 and November 9, 2006.

C. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) that was *used in the inventive process to accomplish the applicant's inventive results.*

D. Provide the date of first use of the claimed invention, known to by any of the inventors or Applicant, at the time the application was filed *notwithstanding* the date of use.

E. Trademark(s) or Copyright(s) for the product(s) incorporating the instant claimed invention.

F. In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated May 24th 2004 and November 9, 2006 as well as each and every IDS submission thereafter, as delineated in requirement A.

Drawings

The drawings are objected to because descriptive labels other than numerical are needed for figures 1-6,7a,b, 8a-c, 9,10, and15-19. See 37 CFR 1.84(o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 11/9/06 is acknowledged. The traversal is on the ground(s) that; "*These claims are directed to an integrated circuit. Additionally, 38-40, 42 and 43 do not expressly require "testing" of an integrated circuit. In the group of claims 38-43, only claim 41 mentions anything about a test routine. As regards claim 38 - this claim is an apparatus claim (integrated circuit) that generally corresponds to claim 18. Applicants have amended claim 38 to make the general correspondence clearer. It is respectfully submitted that the Examiner should withdraw the present restriction requirement, and, if the Examiner believes that a restriction requirement is in order, to restate the requirement.*" As applicant has deleted the independent claim requiring testing, at this point the restriction requirement has

been withdrawn. However, the examiner would like to point out that MPEP states:

811 [R-3] Time for Making Requirement

37 CFR 1.142(a), second sentence, indicates that a restriction requirement "will normally be made before any action upon the merits; however, it may be made at any time before final action." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

811.02 [R-3] New Requirement< After Compliance With Preceding Requirement

Since 37 CFR 1.142(a) provides that restriction is proper at any stage of prosecution up to final action, a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied. Ex parte Benke, 1904 C.D. 63, 108 O.G. 1588 (Comm'r Pat. 1904).

811.03 [R-3] Repeating After Withdrawal Proper

Where a requirement to restrict is made and thereafter withdrawn as improper, if restriction becomes proper at a later stage in the prosecution, restriction may again be required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-24 and 26-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As applicant has argued with respect to the restriction requirement that the claims do not expressly require testing, the examiner would like to be informed what type of programs and data processing within the scope of the specification are being presented as claims. The Specification is almost entirely directed to testing by using algorithms. If the data processed during the data processing within the claims are not directed to testing, and test data, the examiner does not see this in the specification and requests applicant to point out the specific passages within the specification which are directed to data processing while not involving testing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-24 and 26-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As applicant has argued with respect to the restriction requirement that the claims do not expressly require testing, the examiner would like to be informed what type of programs and data processing within the scope of the specification are being presented as claims. The Specification is almost entirely directed to testing by using algorithms. If the data processed during the data processing within the claims are not directed to testing, and test data, the examiner does not see this in the specification and requests applicant to point out the specific passages within the specification which are directed to data processing while not involving testing. This is also indefinite as claims 21, 27, 29, 37, 41, and 46 recite testing and or test routines.

Claims 29 and 27 recites the limitation "the test routine program" in lines 2-3 and lines 1-2 respectively. There is insufficient antecedent basis for this limitation in the claim.

As such, the claims will not be considered in this application with respect to the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Britt whose telephone number is 571-272-3815. The examiner can normally be reached on Monday - Thursday.

The examiner invites applicant to set up an interview to discuss the claims and the above rejection.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cynthia Britt 1-20-07
Cynthia Britt
Primary Examiner
Art Unit 2138

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ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100